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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,258	01/06/2004	Andreas Hund	20793/0204560-US0	4048

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DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

EXAMINER	
CONSILVIO, MARK J	

ART UNIT	PAPER NUMBER
2872	

MAIL DATE	DELIVERY MODE
11/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/752,258	HUND ET AL.	
	Examiner	Art Unit	
	Mark Consilvio	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2008 has been entered.

Status of Claims

Claims 1-23 were previously rejected and claim 1 is newly amended. Claims 1-23 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 10-13, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Westphal (US Patent No. 4,576,450).

With respect to claim 1, Westphal discloses a tube for a microscope, comprising: an adaptation interface (i.e. bottom of 1) configured to convey a light beam from the microscope

along an optical axis; a rotatably disposed operator interface (5); a beam-deflecting device (7, 8) including a beam-splitting device (8), the beam-splitting device being disposed at a first distance perpendicular from an extension of the optical axis; and a rotatably disposed beam deflecting unit (9, 19) disposed on a side of the optical axis opposite the optical interface, a rotation of the operator interface being constrainedly coupled to a rotation of the beam-deflecting unit; wherein the beam-deflecting device is configured to deflect at least a portion of the light beam in a direction of the beam-deflecting unit; wherein the optical axis is defined by a path of the light beam between the microscope and the beam deflecting device; and wherein an axis of rotation (16) of the beam deflecting unit is disposed at a second distance perpendicular from an extension of the optical axis, the second distance being greater than the first distance (figs. 1 and 2).

With respect to claim 2, Westphal discloses the beam-deflecting device includes a deflecting prism (7) (fig. 2).

With respect to claim 10, Westphal discloses at least a portion of the beam splitter device (8) is movable into and out of a working position (col. 4, lines 5-22).

With respect to claim 11, Westphal discloses at least a portion of the beam splitter device (8) is movable into and out of a working position by a magazine slider (col. 4, lines 5-22).

With respect to claim 12, Westphal discloses the operator interface (5) and the beam-deflecting unit (9) are rotatable about a rotation axis (16), the rotation axis being perpendicular to the optical axis of the light beam (figs. 1 and 2).

With respect to claim 13, Westphal discloses, upon a rotation of the operator interface (5) through a first angle, the beam-deflecting unit (9) is configured to rotate through a second angle half as large as the first angle (col. 4, lines 35-40).

With respect to claim 19, Westphal discloses the operator interface (5) includes a binocular element configured for eyepiece viewing by an operator (col. 3, lines 38-40).

With respect to claim 20, Westphal discloses the beam-splitting device is configured to split-off a first portion of the light beam coming from the adaptation interface to a detector (col. 3, lines 41-54 and col. 4, lines 5-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 9, 10, 12-15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki (US Patent Application Publication No. 2001/0030801) in view of Westphal (US Patent No. 4,576,450).

With respect to claim 1, Kawasaki discloses a tube for a microscope, comprising: an adaptation interface (i.e. at G1) configured to convey a light beam from the microscope along an optical axis; a rotatably disposed operator interface (OC); a beam-deflecting device (P1, M1, P2, P3) including a beam-splitting device (i.e. the path dividing element of par. 85), the beam-splitting device being disposed at a first distance perpendicular from an extension of the optical axis (i.e. along the optical path between G1 and G2); and a rotatably disposed beam deflecting unit (M2) disposed on a side of the optical axis opposite the optical interface, a rotation of the operator interface (OC) being constrainedly coupled to a rotation of the beam-deflecting unit;

wherein the beam-deflecting device is configured to deflect at least a portion of the light beam in a direction of the beam-deflecting unit; wherein the optical axis is defined by a path of the light beam between the microscope and the beam deflecting device (i.e. between OB and P1); and wherein an axis of rotation (P) of the beam deflecting unit is disposed at a second distance from the optical axis (figs. 1 and 3). Kawasaki does not expressly disclose the second distance being greater than the first distance because the exact placement of the path dividing element is not foretold. However, insertion of a path dividing element at any reasonably convenient location would have been within the abilities of one of ordinary skill in the art including a position such that the second distance is greater than the first distance. For example, Westphal teaches a similar microscope tube with a beam-deflecting device (7, 8) including a beam-splitting device (8), the beam-splitting device being disposed at a first distance perpendicular from an extension of the optical axis; and a rotatably disposed beam deflecting unit (9, 19) disposed on a side of the optical axis opposite the optical interface; wherein the optical axis is defined by a path of the light beam between the microscope and the beam deflecting device; and wherein an axis of rotation (16) of the beam deflecting unit is disposed at a second distance perpendicular from an extension of the optical axis, the second distance being greater than the first distance (fig. 2). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to arrange the beam-splitting element of Kawasaki such that the second distance is greater than the first distance to achieve the claimed invention because shifting the position of the splitting element would not have modified the operation of the device and the modification would have the yielded predictable result of a more compact microscope tube. See

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

With respect to claim 2, Kawasaki discloses the beam-deflecting device includes a deflecting prism (P1) (fig. 3).

With respect to claim 3, Kawasaki discloses the deflecting prism (P1) is configured to deflect by 90 degrees the light beam coming from the adaptation interface (fig. 3).

With respect to claim 9, Kawasaki discloses optical properties of the beam-deflecting device (P1, M1, P2, P3) are selectable so that a length of an optical path of light beam in the tube is adaptable (par. 76).

With respect to claim 10, Kawasaki discloses at least a portion of the beam splitter device is movable into and out of a working position (par. 85).

With respect to claim 12, Kawasaki discloses the operator interface (OC) and the beam-deflecting unit (M2) are rotatable about a rotation axis (at P), the rotation axis being perpendicular to the optical axis of the light beam (fig. 3).

With respect to claim 13, Kawasaki discloses, upon a rotation of the operator interface (OC) through a first angle, the beam-deflecting unit (M2) is configured to rotate through a second angle half as large as the first angle (par. 72).

With respect to claims 14 and 15, Kawasaki discloses a lens device (G1L) disposed between the adaptation interface and the beam-deflecting device, the lens device having a positive refractive power and the lens device being configured to convert a substantially collimated light beam into a converging light beam (pars. 71-72, 86, and 91).

With respect to claim 19, Kawasaki discloses the operator interface (OC) includes a binocular element configured for eyepiece viewing by an operator (par. 71).

With respect to claim 20, Kawasaki discloses the beam-splitting device is configured to split-off a first portion of the light beam coming from the adaptation interface to a detector (par. 85).

Claims 4-8, 11, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki (US Patent Application Publication No. 2001/0030801) in view of Westphal (US Patent No. 4,576,450) and in further view of Tandler et al. (US Patent No. 6,088,155).

With respect to claims 4-8, 11, and 21-23, the combination of Kawasaki and Westphal discloses or suggests all the limitations of claim 1, 10, and 20 as stated *supra* and also teaches another embodiment wherein the beam deflecting device (G1) includes deflecting prisms (P1 and P2) configured to deflect by 90 degrees the light beam coming from an adaptation interface and a Bauernfeind prism (P3) attached to one of the deflecting prisms (i.e. P2) (fig. 3). Kawasaki further teaches that a beam-splitter such as a removable mirror or prism may be introduced between the beam deflecting prism and beam deflecting unit for providing a photographing path. The combination of Kawasaki and Westphal as stated *supra* does not expressly disclose the beam-splitting device includes a Bauernfeind prism configured to reflect therein twice the at least a portion of the light beam and a prism cemented to the Bauernfeind prism and at least a portion of the beam splitter device is movable into and out of a working position by a magazine slider (though this last feature is generally taught by Westphal). However, Bauernfeind prisms cemented to additional prisms are often used in the prior art as beam splitters to partially direct

the beam path to an additional image capture device. For example, Tandler teaches a switching device for a microscope that uses such a Bauernfeind prism (4) attached to another prism selectively removable from the optical axis via a magazine slider (8, 9) so that the desired transmission can be directed to an operator or image capture device. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to either replace the mirror (M1) of Kawasaki with or additionally include a beam splitting arrangement like that of Tandler since all the elements were known in the prior art, one of ordinary skill could have combined the elements as claimed by known methods and with no change in respective functions, and the combination would have the yielded predictable result of a microscope that allows the image to be selectably directed to observation elements.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchel Kawasaki (US Patent Application Publication No. 2001/0030801) in view of Westphal (US Patent No. 4,576,450) and in further view of Sato (US Patent No. 5,519,531).

With respect to claims 16-18, the combination of Kawasaki and Westphal discloses or suggests all the limitations of claim 1 as stated *supra*. Though combination does not expressly disclose the all further limitations of claims 16-18, Sato teaches an assembly is telescopic in a direction of an optical axis of a light beam and includes a first lens (112) having a negative refractive power and configured to substantially collimate a light beam, a second positive lens (113), and an operator interface (103) (fig. 8). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Kawasaki and

Sato to allow the assembly of Kawasaki to be telescopic as taught by Sato to allow the operator to extend the usable range of the viewer's position making the microscope more ergonomic.

Response to Arguments

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose features similar to those claimed or disclosed by the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272- 2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C./
Examiner, Art Unit 2872

/Arnel C. Lavarias/
Primary Examiner, Art Unit 2872